REMARKS RESPONSIVE TO THE OFFICE ACTION

Claims 1-13 are pending, and Claims 1-13 have been rejected. Reconsideration and allowance are respectfully requested in light of the below presented argument specifically disclosing the distinctions between the references cited and the present invention, and provisions of law cited relevant to the propriety of the rejections made.

Claim 5 is amended for grammatical correction only.

CLAIM REJECTIONS – 35 USC § 102

RE: CLAIM 1

3. Claim 1 is rejected under 35 U.S.C. 102(a) as being anticipated by Tsai et al. (US Pat. 6,352,432.)

APPLICANT'S RESPONSE RE: CLAIM 1

Applicant appreciates Examiner's careful attention to the examination of this application. Applicant respectfully traverses Examiner's rejection. Claim 1 requires first and second product values that are used to solve for a third value; a contest value. Claim 1 also requires relationship of the contest value to an animated graphic file. Tsai lacks the contest value, the solving step and the relationship step.

"Anticipation under Section 102 can be found only if a reference shows exactly what is claimed."[1] Applicant submits that the present invention as claimed in Claim 1, or any other claim, is not anticipated by the disclosure of Tsai. Tsai does not identically disclosure or describe what is claimed, exactly, or even approximately.

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[1] *Titanium Metals Corp. v. Banner*, 778 F.2d 775 (Fed. Cir. 1985).

Regarding anticipation, it is well established that "for a prior art reference to anticipate in terms of 35 USC §102, every element of the claimed invention must be identically shown in a single reference."[2] There is no identical disclosure or description of numerous elements of the claimed invention as required for the rejection to be proper.[3] Specifically, Tsai does not disclose or describe the use of product values. Nor does Tsai disclose or describe *solving* for a mathematical contest value between first and second product values. Tsai merely *compares* human performance indicators. Still further, Tsai does not disclose or describe using a contest value to select an animated contest file from a plurality of such files. Tsai creates an animated contest in real time by using high-low human performance comparisons to engage redundant actions over the length of a song. The differences are manifest and multiple, as further detailed below.

Lastly, there can be no "anticipation by equivalents" as equivalents are a legal theory pertinent to obviousness under Section 103, not to anticipation under 102."[4]

In paragraph 4, Examiner rejects Claim 1, stating as basis, in part:

> *"Tsai et al. teaches a method of displaying competitive product performance data (col 2, lines 28-49, Tsai et al., and Fig. 12.)"*

Applicant respectfully asserts this is incorrect. There is no disclosure or description whatsoever of "a method of displaying competitive product performance data" within the cited section of text, or anywhere else in the reference. The cited reference relates to a player's (singer's) performance of a "karaoke music piece."

Examiner further states:

> *"...Tsai et al. teaches ....determining a first/second product value representing a first/second product's performance (Tsai et al. teach a*

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[2] *In Re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

[3] *In Re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

[4] *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 853 (1989).

different microphone input to represent the first and second signer voice. The voice quality value would be generated and determined. Col 2, lines 1-11, Tsai et al.)

Applicant respectfully asserts this is incorrect. Applicant further respectfully asserts that Examiner is improperly arguing anticipation by equivalents. Not only is this basis for rejection improper, but microphone inputs of karaoke singers are not identical, equivalent, or suggestive of inputting test data from product performance tests.

Examiner further states:

"...Tsai et al. teaches ... solving for a contest value between the first product value and the second product value; (Tsai et al. teach comparing first performance score and second performance score. The contest value would obtain by whoever has lower score point and that would be the contest value. See col 11, lines 6-62, Tsai et al.)

Applicant respectfully asserts this is incorrect. This is an exaggeration of the teaching of Tsai and of the field of endeavor of Tsai. Tsai only discloses a "greater than" - "less than" comparison as noted by the Examiner:

"Tsai et al. teach if the point of performance 1 is higher, a character animation in which character 1 plays tricks corresponding to the frequency point to character 2 is displayed."

Tsai uses only "superiority/inferiority"[5] comparison to create a real time display. When first input data is higher than second input data, first character executes an action against the second, and as second input data is higher than first input data, second character executes an action against the first.[6] This creates a continuous dynamic animation in response to singing.[7]

This action is not identical to, and does not require, creating a third

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[5] *See* U.S. Pat. 6,352,432; Claim 1.

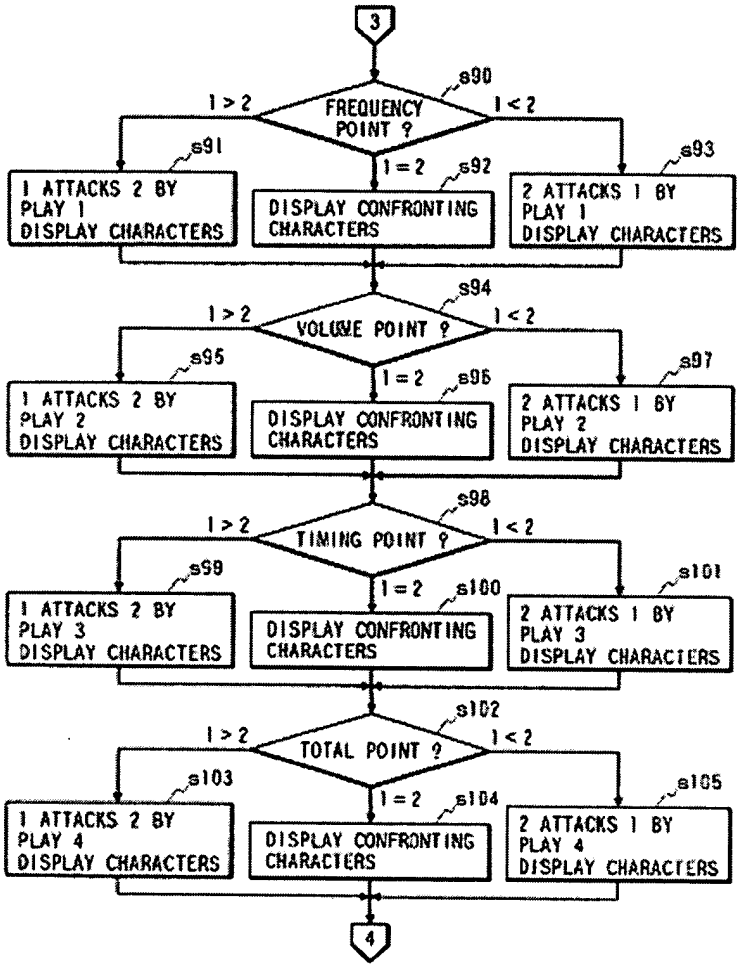
[6] U.S. Pat. 6,352,432; col 11, lines 6-21.

[7] U.S. Pat. 6,352,432; col 11, lines 63-66.

numerical entity as claimed by the Applicant. Tsai only requires a comparison and flowcharting by an "if," "then" programming sequence. Direct evidence of this distinction is found in FIG. 11 of the Tsai patent.[8] See below. In Applicant's invention, the contest value is a separate numerical entity, distinct from the product values (the numbers Examiner compares to the performance value of Tsai). In Applicant's invention, it is the contest value, not the product values, that is, related animated graphic file for selection.

[8] U.S. Pat. 6,352,432; FIG.11; col. 7, lines 61-66.

FIG. 11



In summary, Examiner has asserted an improper anticipation rejection based on art that does not identically disclose or describe numerous elements of Claim 1. For this reason, Applicant submits that Claim 1 is not anticipated, and is allowable.

APPLICANT'S RESPONSE RE: CLAIM 2

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claim 2 depends from Claim 1. Applicant has traversed Examiner's rejection of Claim 1. As such, Applicant respectfully submits that Claim 2 is unobjectionable as depending from an allowable claim.

APPLICANT'S RESPONSE RE: CLAIMS 6 and 7

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claims 6 and 7 depend from Claim 1. Applicant believes he has traversed Examiner's rejection of Claim 1. As such, Applicant respectfully submits that Claims 6 and 7 are unobjectionable as depending from an allowable claim.

APPLICANT'S RESPONSE RE: CLAIM 8

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claim 8 depends from Claim 1. Applicant has traversed Examiner's rejection of Claim 1. As such, Applicant respectfully submits that Claim 8 is unobjectionable as depending from an allowable claim.

APPLICANT'S RESPONSE RE: CLAIM 9

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claim 9 depends from Claim 1. Applicant has traversed Examiner's rejection of Claim 1. As such, Applicant respectfully submits that Claim 9 is unobjectionable as depending from an allowable claim.

APPLICANT'S RESPONSE RE: CLAIM 10

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claim 10 depends from Claim 1. Applicant has traversed Examiner's rejection

of Claim 1. As such, Applicant respectfully submits that Claim 10 is unobjectionable as depending from an allowable claim.

RE: CLAIMS 11 AND 12

10. As per claims 11 and 12, Tsai et al. teach a method of displaying competitive product performance data (See col 3, lines 15-23, Tsai et al.), comprising the steps of:

> *determining a first product value representing a first product's performance; determining a second product value representing a second product's performance;*
>
> *(Tsai et al. teach a different microphone input to represent the first and second signer voice. The voice quality value would be generated and determined. Col 2, lines 1-11, Tsai et al.)*
>
> *associating the (first, second) product value to a (first, second) animated character performance I associating the (first, second) product value to a performance variable of a (first, second) animated character; and*
>
> *displaying an animated contest between the first animated character and the second animated character (See col 4, lines 50-55, and col 10, lines 15-33, Tsai et al.)*

APPLICANT'S RESPONSE RE: CLAIMS 11 and 12

Applicant respectfully traverses Examiner's rejection. Applicant incorporates his argument and cited authority above for the specific purpose of traversing the present rejections as improper under Section 102. Tsai does not identically disclose or describe every element of Claims 11 and 12 as required for

the rejection to be proper.[9] Applicant further respectfully asserts that Examiner is improperly arguing anticipation by equivalents.[10]

As to both Claims 11 and 12, Tsai does not determine "product values" representing a "product's performance." Microphone inputs of karaoke singers is not identical (or equivalent) to inputting test data for products.

As to Claim 11, Tsai does not independently "associate" two product values to separate "animated character performances." Tsai associates the values of two players' performances *to each other* by high low comparison to select a video performance routine reflecting the performance of both players.

As to Claim 12, Tsai does not disclose or describe the use of performance variables anywhere in his reference at all. This is because they are not relevant to the problem Tsai was trying to solve. Specifically, Tsai creates an animated contest in real time by repetitiously displaying a single "trick" in response to the players' performances. Performance variables are disclosed by Applicant to alter the performance of each graphic character and, thus, of the entire animation.

As shown, Tsai does not identically disclose or describe every element of Claims 11 and 12. Thus, Applicant respectfully submits that Claims 11 and 12 are allowable claims.

CLAIM REJECTIONS – 35 USC § 103

RE: CLAIMS 3 AND 4

12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai et al. (US Pat. 6,352,432.)

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[9] *In Re Bond*, 910 F.2d 831 (Fed. Cir. 1990).

[10] *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 9 USPQ2d 1913 (Fed. Cir. 1989), *cert. denied*, 493 U.S. 853 (1989).

APPLICANT'S RESPONSE RE: CLAIMS 3 and 4

Applicant respectfully traverses Examiner's rejection. Applicant submits that Claims 3 and 4 depend from Claim 1. Applicant has traversed Examiner's rejection of Claim 1. As such, Applicant respectfully submits that Claims 3 and 4 are unobjectionable as depending from an allowable claim.

RE: CLAIM 13

14. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afsah (US Pat. No. 6,509,730.), in view of Ekrem (US Pub. No. 2002/0138295.)..

APPLICANT'S RESPONSE RE: CLAIM 13

Applicant appreciates Examiners exhaustive effort to associate the cited references and detailed presentation for the basis of such, as well as the proposed observations of one of ordinary skill in the art.

Applicant respectfully traverses Examiner's rejection. Applicant respectfully submits there is no suggestion or motivation shown for the combination of Afsah and Ekrem and therefore that combination is improper. Applicant submits that, as noted by the Examiner,[16] even the improper combination of Afsah and Ekrem fails to disclose all elements of the present claim. Applicant further submits that Examiner has improperly overstated what the disclosures mean, or "could" mean, as stated in Examiner's rejection. Examiner states:

> *Since, Afsah also teaches comparing two performance values, it would have been obvious to display a contest between two animates characters.*

Applicant respectfully submits there is no proper basis whatsoever for this conclusory statement. The references are completely void of any suggestion to

[16] Office Communication dated 11/01/2005; DETAILED ACTION, p. 7, "Afsah does not teach the animated character to associate with the contest value."

provide any animated contest. To the extent Examiner's cited references fail to disclose or suggest all of the elements of Applicant's claims, Examiner has improperly determined that the essential missing components would have been obvious to one of ordinary skill in the art. Thus, not only is there no suggestion or motivation identified with the reference to provide a proper basis for their combination, the resulting combination is so far from providing Applicant's claimed invention that there isn't even a suggestion of an animated contest.

Examiner further states:

> *Since Ekrem teaches method based on benchmark performance data value (See sec [0026], Ekrem.), it would have been obvious for one having ordinary skill in the art at the time the invention was made to associate the performance value to animated character*
>
> ***and*** *have the animated contest character for comparing two performance value because this would provide the easier comparison for the consumer to compare two performance data by looking the animated graphic display rather than looking at the statistical values.*

Applicant respectfully submits that the presence of the instructional speaking character of Ekrem is far removed from a display of combatants in battle, and from the entire disclosure of Applicant. Applicant again submits there is no basis whatsoever for this conclusory assessment which requires the person of ordinary skill in the art to not only perform multiple observations of what Examiner alleges to be "obvious" (which are not disclosed, described, or suggested in either reference) but to also *combine* the observations to recognize Applicant's invention. Applicant submits that neither Ekrem nor Afsah disclose nor suggest anything related to animated contests. Thus, Examiner has failed to meet his burden of making a *prima facie* showing of obviousness.

CONCLUSION

Applicant appreciates Examiner's thorough review of the prior art, and Examiner's remarks related thereto. The Application has been carefully reconsidered in view of the Office Action of November 1, 2005.

Applicant respectfully asserts that Examiner has relied upon a chain of overstatements of the scope of the teaching of the cited references in a strenuous compilation of improper hindsight analysis. Applicant respectfully submits that, fully understood, the cited references are recognizably distinct in objective, application, function, and result.

On the basis of the above amendments and responses, Applicant respectfully submits that the only stated grounds for rejection of Applicant's claims have been addressed and eliminated. Applicant respectfully asserts that the above response now places this Application in condition for allowance. Consideration of this Application for early allowance is requested.

Enclosed is a check in the amount of $510.00 for the fee associated with three (3) months extension of time in which to respond to the Office Action dated November 1, 2005. Applicant does not believe that any other fees are due; however, in the event that additional fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account 50-2180 of Storm LLP.

Should the Examiner require any further clarification to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the number listed below.

Respectfully submitted,

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